

REMARKS***Claim Objections***

Claim 14 is objected to because of the following informalities: in line 11, "form" should be changed to --from--. Applicants thank the Examiner and the change has been made.

Claim Rejections - 35 U.S.C. § 112

Claims 1-13 and 17-19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Examiner asserted the claim(s) contained subject matter which was not described in the specification in such a way as to reasonably convey one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully refer the Examiner to the third full paragraph on page 9 of the application.

In particular, Examiner stated independent claims 1 and 17, in lines 11-12, reciting "by simultaneously sending to each other one or more types of codes [codecs in claims]", was not supported in the specification as filed. The third full paragraph on page 9 states that both routers may "simultaneously send each other [the] codec(s) that each is capable of supporting". Applicants assert this portion of the specification disclosed and supported "simultaneously sending to each other one or more types of codecs."

Claim Rejections - 35 U.S.C. § 103

Claims 1-13 and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vargo et al. (U.S. Patent No. 6,356,545) ("Vargo") in view of Bauer et al. (U.S. Pub. No. 2001/0008556 A1) ("Bauer") and further in view of Riddle (U.S. Patent No. 6,175,856) ("Riddle").

Claim 1 recites:

A device comprising in part:

the device and the remotely-located device to negotiate a codec by simultaneously sending to each other one or more types of codecs that each supports and selecting a mutually supported codec with a predetermined protocol

Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art

references as a whole. MPEP 2141.02. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Applicants respectfully submit this is not the case and therefore that a prima facie case of obviousness has not been met.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

For claim 1, not all the claim limitations were met by the references even when combined. Applicants agree that Vargo does not disclose that simultaneously sending to each other one or more types of codecs that each supports and each deciding to use a mutually supported coded through the use of a predetermined protocol.

Applicants respectfully disagree that this limitation would be obvious in light of Vargo in view of Riddle, even in view of Bauer. In particular, the limitation of *the device and the remotely-located device to negotiate a codec by simultaneously sending to each other one or more types of codecs that each supports and selecting a mutually supported codec with a predetermined protocol* teaches away from Vargo where codecs are therefore essentially objects and *neither the transport nor any of the other software needs to be compatible with any particular codec*. This is due to the codec encapsulation mechanism used in Vargo.

Vargo further teaches away by stating *as new codecs are introduced, they can be added easily added [sic] without requiring modifications in the higher level system software*. Therefore it would not be obvious in light of Vargo in view of Riddle that *the device and the remotely-located device to negotiate a codec by simultaneously sending to each other one or more types of codecs that each supports and selecting a mutually supported codec with a predetermined protocol*. Claim 1 is therefore patentably distinguishable over the prior art. Claims 2-13 depend from claim 1 and necessarily contain the limitations of claim 1, and as such are also patentably distinguishable over the prior art.

Claim 17 is a method claim with similar limitations to claim 1 but in method format. Claim 17 is patentably distinguishable over the prior art for the same reasons stated above as

claim 1. Claims 18-19 depend from claim 17 and necessarily contain the limitations of claim 17, and as such are also patentably distinguishable over the prior art.

Claims 14-16 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuster et al. (U.S. Patent No. 6,483,600) ("Schuster") in view of Bloomfield-Brown (U.S. Patent No. 5,625,678) ("Bloomfield") and further in view of the admitted prior art disclosed in the specification on pages 1-4 and Fig. 2.

*A device comprising:
a digital signal processor (DSP) module for a telephone conversation through a packet switching network, the DSP module further responsive to analog fax signals from a first fax machine and to convert the analog fax signals to digital and to packetize the digital fax signals for transmission, through the packet switching network, to the second fax machine, the DSP module to negotiate a codec by simultaneously sending to another DSP module one or more types of codecs that each supports and selecting a mutually supported codec with a predetermined protocol, wherein the fax transmission may cause a temporary interruption to the telephone conversation thereby avoiding the need for telephone connection to be disconnected prior to the fax transmission and wherein frequency adjustments are made to compensate for the fax transmission and the telephone signal.*

Schuster discloses a system and method for communicating a facsimile reliably in real-time over data networks but does not disclose a *DSP module to negotiate a codec by simultaneously sending to another DSP module one or more types of codecs that each supports and selecting a mutually supported codec with a predetermined protocol* as required in claim 14.

Blomfield-Brown discloses a method and system for allowing switched voice and data communication among multiple application programs but again, does not cure the deficiencies of Schuster, namely, it does not disclose a *DSP module to negotiate a codec by simultaneously sending to another DSP module one or more types of codecs that each supports and selecting a mutually supported codec with a predetermined protocol* as required in claim 14. Claim 14 is therefore patentably distinguishable over the prior art. Claims 15-16, and 20 depend from claim 14, and necessarily contain the limitations of claim 14, and as such are also patentably distinguishable over the prior art.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-20 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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